

REMARKS

Applicants wish to thank the Examiners, Ms. Alicia Chevalier and Mr. Harold Pyon, for their courtesies extended during the telephonic interview of May 6, 2004. During the telephonic interview, all pending claims were discussed. No agreement was reached with respect to the patentability of the pending claims. This RCE is being filed based on the telephonic interview to further define those features of the invention that distinguish over the references of record.

Claims 1-17 are pending. Claims 4-8, and 10-17 have been amended, where claims 5 and 8 have been placed into independent form. Claims 1-3, and 9 have been canceled. No new matter has been added by way of this amendment. Reconsideration of the application is respectfully requested.

Claims 1-7, 10-17 stand rejected under 35 U.S.C. 112, 1st ¶, as failing to comply with the written description requirement. According to the remarks in the Office Action of January 27, 2004:

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation "uppermost portions of respective protrusions defining contact points only at locations where said top sheet comes into contact with a [wearer's] skin" is new matter. The limitation is constructed to mean that only the uppermost portions of the protrusions are in contact with the [wearer]. The Examiner is unable to find support for this limitation in the specification or the drawings. Applicant's response on page 5, the last paragraph, alleges that support may be found on page 11, line 20 thru page 12, line of the specification. Page 11, line 20 thru page 12, line of the specification recites:

“The load in compression of the protrusions 5, i.e., a LC value thereof preferably falls between 0.05 and 0.5. The LC value indicates the behavior of the protrusions under compression, and is measured by use of the texture feel tester, Katotec’s KES. If their LC value is smaller than the lowermost limit of the defined range, the protrusions will be readily crushed by the pressure of the body of wearers. If their LC value is larger than the uppermost limit of the defined range, their compressive resistance will increase and therefore the protrusions will be hard.”

This section of the specification only discusses how different load compressions will affect the top sheet, i.e. if the LC is too [small] the protrusions will be crushed and alternatively if the LC is too large the protrusion will feel hard. The section does not recite anything about how or where the top sheet contacts the wear. As such the limitation is deemed to be new matter and should be removed from the claims.

Claims 1, 11, 15 and 17 recite, “so that apexes of respective protrusions extend toward a wearer’s skin beyond the apexes of said fine convex portions to define contact points which contact the wearer’s skin.” The specification does not disclose “contact points” which are defined the “apexes of respective protrusions extending toward a wearer’s skin beyond apexes of said fine convex portions,” therefore this limitation is considered new matter. The passage, specification page 11, lines 5-15, upon which Applicant [contends] gives support for the new limitations does not discuss “contact points.” The passage Applicant has pointed out merely discusses that the protrusions will not function correctly if their height is below the lower limit of the protrusion height range. Furthermore, the only [discussion] of a “contact area” in the specification is in regard to the fine convex portion, see page 6, line 19.

Claim 13 has been amended to now recite “a height of each protrusion being in a range greater than 0.0837 mm to 1.0 mm.” The specification does not disclose that the “protrusion height is greater than 0.0837 mm to 1.0 mm,” therefore this limitation is considered new matter. The specification only has support for protrusion height ranges of 0.05 mm to 1.0 mm (*page 11, line 6*) and 0.35 mm to 0.55 (*page 16, line 7*).

The new matter should be deleted.

Claims 14-17 recite, “said fine convex portions including first fine convex portions defined by exposing a part of a first particulate material having a first grain size and second fine convex portions

